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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,804	07/02/2003	Edward B. Ferguson	1634.0080001/DKSC	9002

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EXAMINER

ESTREMSKY, GARY WAYNE

ART UNIT	PAPER NUMBER
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3676

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/620,804

Applicant(s)

FERGUSON, EDWARD B.

Examiner

Gary Estremsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7, 8, 10 and 12-15 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 7, 8, 12 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-3, 5, 7, 8, and 13-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It's not clear what scope of structure should be included by limitation of "switching means,...". The written description does not use the term "switching means" but describes several disparate embodiments with different structural arrangements for allowing a magnet(s)'s poles to be switched so as to provide either an attractive or repulsive force. It is not clear if present limitation should be read as including only the structure of one, or more than one embodiment. See MPEP 2181-2185. It's noted that a claim having a proper 'means for' limitation is interpreted as including the structure that has been disclosed corresponding to the limitation and its equivalents, and that such interpretation does not excuse the claim from requirement that it's scope and meaning be clear. Examiner notes that written description of three embodiments uses the term 'switch' (but not "switching means") but that description of other embodiments uses equivalent terminology of "select", "shift", etc..

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Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-3, 5, 7, 8, 10, and 13-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,588,811 to Ferguson. Although the conflicting claims are not identical, they are not patentably distinct from each other because one of ordinary skill in the art would recognize their scope differs only so far as to cover the obvious variants of the same invention when the claims are properly read in light of the specification.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 5, 7, 8, and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 3,790,197 to Parker.

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Parker '197 teaches Applicant's claim limitations including : a "first magnet" - 15, "mounted on a door" - 11, a "second magnet" - 13, "mounted on a structure opposing the door (doorframe)" - portion of 10 adjacent to the door, "switching means" - including 18, 22 where limitation of "switching means" has 'as best understood' been disclosed in diverse embodiments including structural repositioning of permanent magnets by rotation of a knob or by disassembly and reassembly, or by reversing poles of electromagnets. Consequently, the "switching means" limitation must also be interpreted broadly where the reference has disclosed position of magnets to reorient the poles for attraction/repulsion that being substantially the same as structure disclosed by Applicant. See MPEP 2181-2185. It's noted that the structure of the reference is inherently capable of decelerating the door if the handle is held in the position of Fig 2 while the door is being closed. The structure of the prior art is equivalent to the structure disclosed by Applicant for performing the recited function. It is additionally noted that grammatically, the "wherein" clause is phrased as a capability associated with the structure covered by the means-plus-function limitation preceding. It does not appear that the "wherein" clause positively recites a 'step' in a *process of using*. However, Applicant's attention is directed to MPEP 2173.05(p) section II. Otherwise, it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

2. Claims 1, 2, 5, 7, 8, and 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 2,797,655 to Morehouse.

Morehouse '655 teaches Applicant's claim limitations including : a "first magnet" – 69 or 70 as shown in Fig 14 for example, a "second magnet" – 63 or 64 respectively as shown in Fig 12 for example, "switching means is a magnet holder comprising a bottom" – plate 71 as shown in Fig 14, "and two opposing sidewalls extending from the bottom" – the holder's sidewalls encasing magnets 69 as those sidewalls are shown best in Fig 12 for example. The law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it. *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 789. Furthermore, claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

As regards claim 2, at least during assembly, the magnet "may be placed between the two sidewalls". It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. It is suggested that particular structure of the connection between the sidewalls and the magnet be explicitly defined in the claim since present limitation lends itself to broad interpretation.

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As regards claim 5, it's noted that the structure of the reference is inherently capable of decelerating the door if the handle is rotated to the repel position while the door is being closed. The structure of the prior art is equivalent to the structure disclosed by Applicant for performing the recited function. It is additionally noted that grammatically, the "wherein" clause is phrased as a capability associated with the structure covered by the means-plus-function limitation preceding. It does not appear that the "wherein" clause positively recites a 'step' in a *process of using*. However, Applicant's attention is directed to MPEP 2173.05(p) section II. Otherwise, it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

3. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 2,471,635 to Mark.

Mark '635 teaches Applicant's claim limitations including : a "first magnet" – 6, a "second magnet" – including 12,13, a "switching means" – the switch described in written specification for switching from attraction to creating a repulsion, "magnet holder comprising a bottom and two opposing sidewalls extending therefrom" – 8 as shown on the face of the Patent. Limitation of "switching means" is not given weight in accordance with 35 USC 112, 6th paragraph since the structure for performing the function is explicitly set forth in the claim. See MPEP 2181-2185.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 3,647,165 to Whitla.

Whitla '165 teaches Applicant's claim limitations including : a "door" - 34, a "magnet" - 35, "mounted on a structure opposing the door" - 36, 'as best understood' limitation of "switching means" has been disclosed in diverse embodiments including: structural repositioning of permanent magnets by rotation of a knob, or by disassembly and reassembly, or by reversing poles of electromagnets. Consequently, the "switching means" limitation corresponding with diverse disclosure is rightfully interpreted broadly where the reference has disclosed switching poles of an electromagnet that is substantially the same as structure disclosed by Applicant. See MPEP 2181-2185.

Although Whitla '165 discloses a "permanent magnet" (42) on the "door" and an electromagnet on the door frame, it would have been an obvious design choice for one of ordinary skill in the art at the time of the invention to reverse their respective locations as a design choice, for example as a manufacturing convenience. One of ordinary skill in the art would have more than a reasonable expectation of success since the proposed modification would not otherwise affect the function of the device and it has

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been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167.

Response to Arguments

6. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Applicant's careful attention to issues in this Application are appreciated. In view of past prosecution and Applicant's arguments, it is the examiner's belief that the scope of the claims, especially as regards which embodiments are covered, is a primary issue presently. As noted above, the specification does not specifically describe what structure is covered by "switching means for,..." limitations. It is the examiner's position that one of ordinary skill in the art would consider each disclosed embodiment of the invention to have some form of 'switching' structure. Because of the disparate structure of the various embodiments as regards switching magnetic poles, one of ordinary skill in the art would have to interpret equivalents broadly as well.

As regards double-patenting rejections; claim 1 was indicated to be drawn to the elected embodiment in the election of species requirement in the parent case, and cancelled to place the Application into condition for allowance. Examiner notes that magnet holder shown in Fig 11 for example has a base and two opposing sidewalls and reads on the elected embodiment. Double-patenting is required. 'As best understood' independent claims 5 and 12 as now amended read on the embodiment of invention elected in the parent. The above is considered a new grounds of rejection in that

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respect necessitated by amendment. Similar consideration applies to new claims, where 'as best understood' the "means" claimed therein is properly interpreted to include any one of the structures disclosed for performing the function (and their equivalents), a specific embodiment of which is claimed in the Parent. Accordingly, double-patenting is required. As noted during telephone interview, should two patents for the same invention be assigned to different assignees, it would appear that each would have the right to exclude the other (and the public at large) from making the invention.

Applicant's arguments against the prior art rely on some particular intention of how it might be used, as a difference. However, it is the examiner's position that the prior art teaches structure that reads on all explicit structural limitations and is inherently capable of functioning as recited. For example, the claim does not exclude the handle of the prior art from being held against its spring bias during the shutting motion of the door. The claim is for a *product*, defined by its structure, not a *process of using*. While functional limitations are not ignored, they often result in broad limitations at best. See MPEP 2114.

Arguments regarding the "decelerating motion" being a patentable distinction from the prior art and being given weight in accordance with 35 USC 112, 6th paragraph are not entirely persuasive for two reasons. A proper 'means plus function' limitation in a *product* claim is a structural limitation; it includes the structure that has been disclosed for performing the recited function and its equivalents. The prior art teaches mechanical structure for switching that is analogous to the disclosed mechanical structure but also

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notes that 'as best understood', Applicant has disclosed "switching means" to be broad, comprising several variations in mechanical structure for performing the function, and electrical structure in the case of an electromagnet. Broad interpretation consistent with the disclosure is appropriate. Secondly, the 'decelerating' portion of the claim is grammatically included in a functional clause describing a capability of the 'means plus function' limitation and is not phrased as part of the function in the 'means plus function' limitation. Otherwise, it's noted that claim 1 for example, is not given weight in accordance with 35 USC 112, 6th paragraph since it explicitly includes structure for performing the recited function. See MPEP 2181-2185. contrary to Applicant's arguments, the prior art teaches "switching means for selectively orienting said first magnet between a first position of repulsion,..." that is equivalent to structure disclosed by Applicant for switching. One of ordinary skill would recognize that the prior art is inherently capable of being used to decelerate the door as it closes.

Since Applicant's amendment did not necessitate the new grounds of rejection in view of Morehouse '655 or Mark '635, this Office Action is not made Final.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Estremsky whose telephone number is 703 308-0494. The examiner can normally be reached on M-Thur 7:30-6.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Will can be reached on 703 308-3870. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary Estremsky
Primary Examiner
Art Unit 3676